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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,421	01/07/2002	Dave Parsons	CV-0290	3678

7590 10/06/2004
Bristol Myers Squibb Company
100 Headquarters Park Drive
Skillman, NJ 08558

EXAMINER

PAK, JOHN D

ART UNIT PAPER NUMBER

1616

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,421

Applicant(s)

PARSONS ET AL.

Examiner

JOHN PAK

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claims 9-16 are pending in this application. This Office action is in reply to applicant's remarks of 7/2/2004.

For the reasons of record the restriction requirement is maintained. See the Office action of 3/31/2004, pages 2-3. Claim 16 stands withdrawn from further consideration as being directed to non-elected subject matter. Claims 9-15 will presently be examined.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-11, 13-14 stand rejected under 35 U.S.C. 102(b) as being anticipated by Winicov et al. (US 4,271,149) for the reasons of record.

Applicant's arguments have been given due consideration, but they were deemed unpersuasive. Applicant argues the differences in the purpose for Winicov's pH and applicant's pH. The Examiner maintains that the pH range disclosed by Winicov et al. is sufficient because for anticipation, Winicov et al. do not need to disclose the same reason for using such pH range. Applicant also argues that "in the present application, an oxidant and the iodine are kept separately until application." The Examiner has thoroughly addressed this feature in the previous Office action (page 4 of the Office action mailed on 3/31/2004). Applicant fails to take into account the fact that the claims

are readable on the final mixture, i.e. the mixture after combining the iodide with the oxidant. It is this claim scope that is anticipated. Applicant argues further that certain embodiments of the application result in a gel or film. Applicant is reminded that the Examiner examines claims, not some unclaimed embodiments. Applicant argues that Winicov et al. do not do not disclose controlled release of iodine during product use or generating iodine in the product use. The Examiner maintains that such features had been fully addressed on page 5 of the 3/31/2004 Office action. See the slow release disclosure in Winicov et al., column 2, lines 38-40. The "capable" of generating iodine feature at various amounts per gram of composition per hour is a very broad claim language (what makes it capable, does it merely have to have enough reserve iodine, does it have to actually produce the amount or is it enough to make it possible to somehow produce it), and the Examiner showed through calculations that it would have been so "capable" within the broad meaning of such term. As for the argument that the iodine level in Winicov et al. is too high for wounds, such an argument is hardly plausible since Winicov's composition is stated to be effective for topical applications for bovine mastitis, which would necessarily include certain bovine skin irritations that would fall within the ambit of wounds. If applicant means too high for human skin, that is not what the claims presently set forth as a claim requirement.

For these reasons the rejection is maintained.

Claims 9 and 15 stand rejected under 35 U.S.C. 102(b) as being anticipated by Bentley et al. (US 5,128,136) for the reasons of record.

Applicant's arguments have been given due consideration, but they were deemed unpersuasive. Applicant argues that Bentley's pH range is different and Bentley does not teach a controlled release of iodine. First, Bentley's pH explicitly includes 5.5. pH 5.5 is within applicant's pH 4.5 to 6. Second, nowhere in applicant's rejected claim language is there a mention of controlled release of iodine. The Examiner maintains that it is the claims that are being examined, and ~~the~~ claims 9 and 16, as currently presented in their broad language, are anticipated by Bentley's teachings.

Claims 12 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Winicov et al. in view of Bentley et al. for the reasons of record.

Applicant's arguments have been given due consideration, but they were deemed unpersuasive. Applicant argues that the combination of Winicov et al. and Bentley et al. is not appropriate. The suggestion to combine the teachings of Winicov et al. and Bentley et al. arises from the fact that both references are directed to the use of iodine for antimicrobial purposes. Bentley's use of iodide + iodate iodine generating system would have suggested to the ordinary skilled artisan that Winicov's iodide and iodate containing composition would also generate iodine and would be similarly suitable for treating wounds. Applicant further argues unclaimed claim features, and as before, the

Examiner maintains that the *claimed* invention features have all been fairly suggested by the combined teachings of the cited references.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Gary Kunz, can be reached on **(571)272-0887**.

The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

A handwritten signature in black ink, appearing to read 'John Pak', is positioned above the printed name and title.

JOHN PAK
PRIMARY EXAMINER
GROUP 1616